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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,920	10/11/2005	Shoichiro Watanabe	043888-0399	6930
53080	7590	09/18/2009	EXAMINER	
MCDERMOTT WILL & EMERY LLP			ARCIERO, ADAM A	
600 13TH STREET, NW				
WASHINGTON, DC 20005-3096			ART UNIT	PAPER NUMBER
			1795	
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			09/18/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/552,920	WATANABE ET AL.
	Examiner	Art Unit
	ADAM A. ARCIERO	1795

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 20 July 2009.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1 and 4-9 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1 and 4-9 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>08/17/2009</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application
	6) <input type="checkbox"/> Other: _____

**NONAQUEOUS ELECTROLYTE BATTERY AND CHARGE/DISCHARGE SYSTEM
THEREOF**

Examiner: Adam Arciero S.N. 10/552,920 Art Unit: 1795 September 4, 2009

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 09, 2009 has been entered.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. The claim rejections under 35 U.S.C. 103(a) as being unpatentable over INOUE et al. on claims 1 and 6 are maintained.

As to Claims 1, 6 and 8, INOUE et al. teaches a lithium-ion battery comprising a positive electrode having an active material layer, a negative electrode comprising a negative active material layer, a separator and a lithium-ion conductive non-aqueous electrolyte (col. 6, lines 30-61). Said positive active material comprises a lithium transition metal composite oxide (col. 11, lines 10-50) and said negative material comprises graphite (claim 8) (col. 15, lines 24-45) which is capable of intercalating and deintercalating lithium ions (col. 6, lines 30-61). The final charge

voltage of said non-aqueous battery is set to 4.3 V (col. 44, Example 2). INOUE et al. teaches a positive active material comprising a lithium transition metal composite oxide represented by the formula: $\text{Li}_x\text{Co}_a\text{Ni}_{1-a}\text{O}_2$ wherein $x=0.2$ to 1.2 and $a=0.1$ to 0.9 . The prior art ranges taught by INOUE et al. overlap the claimed ranges. The courts have held that in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). INOUE et al. does not expressly disclose the capacity ratio of the positive active material to negative active material as being 1.5 to 2.2. However, INOUE et al. teaches the ratio for the contents of the positive active material and negative material, depending on the varieties of the compounds and formulations of the compositions, can be optimized so as to improve the capacity, cycle life and safety of the battery (col. 33, lines 36-59). INOUE et al. is teaching that said ratio is a results effective variable. The courts have held that optimization of a results effective variable is not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

4. The claim rejections under 35 U.S.C. 103(a) as being unpatentable over INOUE et al. on claim 2 and over INOUE et al. and LU et al. on claim 3 are withdrawn, because claims 2-3 have been canceled.

5. The claim rejections under 35 U.S.C. 103(a) as being unpatentable over INOUE et al. and SHOICHIRO et al. on claims 4-5 are maintained.

As to Claim 4 and 9, INOUE et al. teaches a lithium-ion battery comprising a positive electrode having an active material layer, a negative electrode comprising a negative active material layer, a separator and a lithium-ion conductive non-aqueous electrolyte (col. 6, lines 30-61). Said positive active material comprises a lithium transition metal composite oxide (col. 11, lines 10-50) and said negative material comprises graphite (claim 9) (col. 15, lines 24-45) which is capable of intercalating and deintercalating lithium ions (col. 6, lines 30-61). The final charge voltage of said non-aqueous battery is set to 4.3 V (col. 44, Example 2). INOUE et al. teaches a positive active material comprising a lithium transition metal composite oxide represented by the formula: $\text{Li}_x\text{Co}_a\text{Ni}_{1-a}\text{O}_2$ wherein $x=0.2$ to 1.2 and $a=0.1$ to 0.9 . The prior art ranges taught by INOUE et al. overlap the claimed ranges. The courts have held that in the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). INOUE et al. does not expressly disclose a lithium transition metal composite oxide comprising two composite oxides represented by the two separate formulas in claim 4.

However, SHOICHIRO et al. teaches a nonaqueous electrolyte secondary battery having a positive active material mixture comprising two positive active materials (Abstract). The first active material is $\text{Li}_x\text{Co}_y\text{M}_w\text{O}_z$ wherein $x = 0.9$ to 1.1 , $y = 0.85$ to 0.98 , $w = 0.02$ to 0.15 and $z = 1.8$ to 2.2 and M is at least one of Al, Cu, Zn, Mg, Ca, Ba and Sr (Abstract). The second positive material is represented by the formula $\text{Li}_a\text{Ni}_b\text{M}'_c\text{O}_d$ where $a = 0.3$ to 1.02 , $b = 0.5$ to 0.98 , $c = 0.02$ to 0.5 , $d = 1.8$ to 2.2 and M' is at least one of Co, Mn, Cr, Fe, V and Al (Abstract). These ranges overlap or lie inside the claimed ranges of the present application. The courts have held that in

the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art” a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990). Therefore, at the time of the invention, it would have been obvious to a person having ordinary skill in the art to use a mixture of two positive active materials to create a composite positive active material so as to heighten a discharge capacity, create a low temperature characteristic and improve a cycle characteristic, as suggested by SHOICHIRO et al. (Abstract).

INOUE et al. and SHOICHIRO et al. does not expressly disclose the capacity ratio of the positive active material to negative active material as being 1.5 to 2.2. However, INOUE et al. teaches the ratio for the contents of the positive active material and negative material, depending on the varieties of the compounds and formulations of the compositions, can be optimized so as to improve the capacity, cycle life and safety of the battery (col. 33, lines 36-59). INOUE et al. is teaching that said ratio is a results effective variable. The courts have held that optimization of a results effective variable is not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

As to Claim 5, INOUE et al. teaches the ratio for the contents of the positive active material and negative material, depending on the varieties of the compounds and formulations of the compositions, can be optimized so as to improve the capacity, cycle life and safety of the battery (col. 33, lines 36-59). INOUE et al. is teaching that said ratio is a results effective variable. The courts have held that optimization of a results effective variable is not novel. *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

6. The claim rejections under 35 U.S.C. 103(a) as being unpatentable over INOUE et al. and FERNANDEZ et al. on claim 7 is maintained.

As to Claim 7, INOUE et al. does not expressly disclose a charge/discharge system comprising a battery as recited in claim 1 and a charger, wherein said charger is set to stop charging when the voltage of said battery reaches 4.25 to 4.5 volts.

However, FERNANDEZ et al. teaches a charger for lithium ion cells wherein an overvoltage based disconnect circuit is used so as to disconnect the battery from the charger if the voltage of the cell reaches a threshold level (col. 1, lines 56-65). At the time of the invention, it would have been obvious to a person having ordinary skill in the art to employ a charger for charging the battery of INOUE et al. with a disconnect circuit so as to stop charging the battery of INOUE et al. when said battery reaches its final charge voltage of said non-aqueous battery is set to 4.3 V (col. 44, Example 2), sp as to protect the battery from overcharging, as suggested by FERNANDEZ et al.

Response to Arguments

7. Applicant's arguments filed on July 20, 2009 have been fully considered but they are not persuasive.

Applicant's principle arguments are:

a) The weight ratio of positive active material to negative active material being between the claimed range of 1.5 to 2.2 only in the area where the electrodes are opposed to each other, provides the battery with unexpected superior results shown in Tables 2 and 3 (claims 1 and 4).

In response to Applicant's arguments, please consider the following comments.

a) The instant disclosure teaches the weight ratio of positive material to negative material can improve the charge and discharge cycle characteristics and decrease the thermorunaway temperature. However, the Applicant has not established the differences in results that are in fact consistently unexpected and unobvious and of both statistical and practical significance. The different weight ratios of the active materials does not provide results that are consistently superior. For example, in Table 2 for Batteries 1-3 wherein the ratio is below the claimed range lower limit of 1.5, the results for capacity maintenance rates are very similar to Batteries 4-7. Furthermore, Table 3 shows Batteries 24-25, which fall within the claimed ratio range, does not have results consistent with Batteries 4-23 and 26-29. The burden is on Applicant to establish results that are consistently unexpected and significant. See MPEP 716.02(a) and (b).

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM A. ARCIERO whose telephone number is (571)270-5116. The examiner can normally be reached on Monday to Friday 8am to 5pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dah-Wei Yuan can be reached on 571-272-1295. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1795

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AA

/Dah-Wei D. Yuan/
Supervisory Patent Examiner, Art Unit 1795